

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	
)	
Samantha Stetson, et al.)	
)	Examiner: Raquel Alvarez
Application No: 10/092,369)	
)	Art Unit: 3688
Filed: March 6, 2002)	
)	Confirmation No: 8236
For: METHOD AND APPARATUS FOR)	
SERVING A MESSAGE IN)	
CONJUNCTION WITH AN)	
ADVERTISEMENT FOR DISPLAY ON)	
A WORLD WIDE WEB PAGE)	
)	

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APPEAL BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

This Brief is submitted in support of an appeal from a final decision by the
Examiner, mailed on December 22, 2008 and a Notice of Appeal filed on March 20, 2009
in the above-referenced case.

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I. REAL PARTY IN INTEREST

The real party in interest is IAC Search & Media, Inc., a corporation of Delaware, having a principle place of business at 555 West 18th Street, 8th Floor, New York, NY, 10011.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Current Pending Claims:

Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 49-56, 58, 60, 72, 74, and 78-82 are currently pending.

In particular, Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 49-56, 58, 60, 72, 74, and 78-82 are rejected under 35 USC 103(a) as being unpatentable over US Patent Number 6,128,663 to Thomas, hereinafter "Thomas" in view of Official Notice.

Status of Non-Pending Claims:

Claims 2-3, 6-7, 9-10, 15, 20, 23, 27-30, 32, 34, 36, 43-44, 47, 52-53, 63, 66, 70-71, 73 and 76-77 were cancelled in a Preliminary Amendment filed on March 6, 2002.

Claims 38-42, 61-62, 64-65, 67-69 and 75 were cancelled in response to the Restriction Requirement issued on September 5, 2007.

Claims 78-82 were introduced as new claims in the response to Restriction Requirement issued on September 5, 2007.

Claims 4, 5, 57 and 59 were cancelled in the Amendment and Response to Office Action issued on December 31, 2007.

IV. STATUS OF AMENDMENTS

There are no presently pending amendments.

VII. ARGUMENT

1. THE PRESENT CLAIMS ARE PATENTABLE OVER THOMAS IN VIEW OF OFFICIAL NOTICE:

In Thomas, column 4, lines 53-65 state as follows:

"A remote server receiving a page request (e.g., from such modified pages or modified page requests) is able to obtain the demographic identifier and use the demographics identifier to modify the content of the requested page to be transmitted over the network to the user such that it is more appropriate for the user. For example, the requested page often includes an advertising banner, and according to the invention, the particular advertising banner that is chosen to be transmitted with the requested page is determined, not randomly, but in accordance with the demographics identifier. Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc. "(Emphasis added)

What is clear from Thomas is that the following are served by a server to a client:

1. the requested page;
2. an advertising banner based on demographics; and
3. a customized greeting

What should be noted is that the greeting of Thomas is not related to the advertisement. Just because selection of an advertising banner to be displayed is based on a demographic profile and selection of a greeting to be displayed is based on a separate demographic profile does not mean that the greeting is related to the advertisement in general, or thematically related to the advertisement in particular. For example, a served World Wide Web page may include an advertisement directed to restaurants that is selected based on a demographic of people earning \$20,000 to \$30,000 and an advertising banner directed to a department store that is selected based on a demographic of people earning \$20,000 to \$30,000. Although both the advertisement and the banner ad were selected using demographic information, the demographic information of the

advertisement is clearly not thematically related to the demographic information of the banner ad. Thus, claim 1 includes at least one limitation that is not suggested by Thomas.

In the Final Office Action dated December 22, 2008, the Examiner states that the banner ad of Thomas “is equivalent to the tailored message in the claims and the requested page is equivalent to the advertisement being claimed.” The Examiner also states that “Thomas teaches the banner ad or tailored message being related to the page requested and based on the user’s demographic information.” Thus, it seems that the Examiner is asserting that a page and a banner ad chosen for display based on demographic information are equivalent to the thematic relationship of claim 1. However, as pointed out above, this assertion is flawed at least because the demographic information of the advertisement is not related to the demographic information of the banner ad.

All the other claims rejected by the Examiner have limitations similar to the limitation in claim 1 that distinguishes over Thomas and should therefore be allowable for at least the same reasons as Claim 1.

Furthermore, Thomas fails to disclose both determining targeting criteria associated with a message that is thematically related to an advertisement and tailoring a message based on said targeting criteria as recited in independent claims 1, 56, 58, and 72 and as required by dependent claims 8, 11-14, 16-19, 21, 22, 24-26, and 60. Instead, Thomas relies solely on demographic information or a demographic identifier to determine or customize a file for a response to a request (Thomas, see e.g. Figures 2A, 4B, col. 7, lines 7-17). The Examiner cites the following portion of Thomas as teaching the personal information and targeting criteria of the present claims: a “particular advertising banner that is chosen to be transmitted with the requested page is determined not, randomly, but in accordance with the demographic identifier...selecting appropriate variant of the requested

page.” The Examiner then asserts that “Thomas teaches the message (banner) being based on demographic identifier and appropriate variant so therefore the message or banner are not chosen randomly but customized based on the demographic and user interests.” Final Office Action, page 6. However, even if the Examiner’s assertion were true (which the Applicants do not admit) Thomas still fails to disclose tailoring a message based on targeting criteria associated with a message that is thematically related to an advertisement as recited in the present claims.

All the other claims rejected by the Examiner have limitations similar to the limitation in claim 1 that distinguishes over Thomas and should therefore be allowable for at least the same reasons as Claim 1. Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 under 35 U.S.C. § 103 as being unpatentable over Thomas.

Official Notice

The Examiner has taken Official Notice of the following:

1. That it is old and well-known to receive personal information from a user such as a user’s name, age and gender when a user fills out an application and the like;
2. That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user’s attention to the ad;
3. That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed;
4. That changing display attribute within a message such as changing display color or image will bring the user’s attention to the message; and
5. That it is old and well-know to serve default messages when targeting criteria hasn’t been met. For example, default messages for or general messages are displayed to the customer when the

customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Even if the Applicants agreed with the Examiner's taking of Official Notice of the above points, they still fail to overcome the above noted deficiencies of Thomas. As such, the combination of Thomas and Official Notice fails to teach or suggest each and every element of the present claims.

Furthermore, Applicants respectfully reject as improper the Examiner's taking of Official Notice of the above and note that the Examiner has failed to provide prior art and convincing arguments for why such prior art would be integrated with Thomas by one skilled in the art. Applicants note that the present application was filed on June 3, 2002 and respectfully assert that the prior art requested by Applicants would not be combined with Thomas by someone of ordinary skill in the art at the time that the invention was made.

Thus, for at least the reasons provided above, Thomas even when considered with Official Notice, fail to teach or suggest each and every element of the present claims. Therefore, the present claims are patentable over Thomas in view of Official Notice.

VIII. CONCLUSION

For the foregoing reasons, Appellant respectfully asserts that Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 49-56, 58, 60, 72, 74, and 78-82 overcome the cited references and are therefore patentable. For the reasons presented herein, the removal of the present rejections and allowance of the present claims is respectfully requested.

Charge Our Deposit Account

If there are any further charges not accounted for herein, please charge them to our Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHN NATH & ROSENTHAL LLP

Dated: May 20, 2009

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IX. APPENDIX A: CLAIMS

The claims on appeal read as follows:

1. (Previously Presented) A method for displaying a message in conjunction with an advertisement on a World Wide Web page, comprising:
 - determining an advertisement to be displayed on a World Wide Web page;
 - determining a message to be displayed on said World Wide Web page,
 - wherein said message is thematically related to said advertisement;
 - determining targeting criteria associated with said message;
 - receiving a request to serve said World Wide Web page from a user;
 - receiving personal information about the user;
 - serving said World Wide Web page;
 - serving said advertisement for display on said World Wide Web page,
 - tailoring said message page based, at least in part, on said targeting criteria and said personal information; and
 - serving said tailored message for display on said World Wide Web page separate from said advertisement.
- 2-7. (Cancelled)
8. (Original) The method of claim 1, further comprising:
 - determining personal information prior to said serving said tailored message.
- 9-10. (Cancelled)
11. (Original) The method of claim 1, further comprising:
 - setting a first time period.
12. (Original) The method of claim 11, wherein said serving said tailored message occurs at least said first time period after said serving said World Wide Web page.

13. (Original) The method of claim 11, wherein said serving said tailored message occurs at least said first time period after said serving said advertisement.
14. (Original) The method of claim 1, wherein said serving said messages includes causing said tailored message to be displayed on said World Wide Web page for at least a fixed period of time.
15. (Cancelled)
16. (Original) The method of claim 1, wherein said serving said tailored messages includes causing said tailored message to be displayed on said World Wide Web page for a fixed period of time.
17. (Original) The method of claim 1, further comprising:
causing said tailored message to no longer be displayed on said World Wide Web page; and
serving a second message.
18. (Original) The method of claim 1, further comprising:
determining if said targeting criteria has been met prior to said serving said tailored message.
19. (Original) The method of claim 1, further comprising:
determining if said targeting criteria has been met prior to said serving said advertisement.
20. (Cancelled)
21. (Original) The method of claim 1, further comprising:
determining external information.

22. (Original) The method of claim 21, wherein said tailoring said message is based, at least in part, on said external information.
23. (Cancelled)
24. (Original) The method of claim 1, wherein said World Wide Web page is arranged such that said advertisement is displayed proximal to said tailored message.
25. (Original) The method of claim 1, wherein said World Wide Web page is arranged such that said tailored message is displayed within said advertisement.
26. (Original) The method of claim 1, further comprising:
changing a display attribute of at least a portion of said tailored message.
- 27-30. (Cancelled)
31. (Previously Presented) A method for displaying a message in conjunction with an advertisement on a World Wide Web page, comprising:
determining an advertisement to be displayed on a World Wide Web page;
determining a plurality of messages associated with said advertisement wherein each of said plurality of messages is thematically related to said advertisement;
determining targeting criteria associated with said plurality of messages;
determining personal information;
receiving a request to serve said World Wide Web page;
serving said World Wide Web page;
serving said advertisement for display on said World Wide Web page;
selecting at least one of said plurality of messages based, at least in part, on said personal information and said targeting criteria; and
serving said at least one of said plurality of messages for display on said World Wide Web page separate from said advertisement.
32. (Cancelled)

33. (Original) The method of claim 31, further comprising:
tailoring said at least one of said plurality of messages based, at least in part, on
said personal information prior to serving said at least one of said plurality of messages.
34. (Cancelled)
35. (Original) The method of claim 31, further comprising:
tailoring said at least one of said plurality of messages prior to serving said at least
one of said plurality of messages.
36. (Cancelled)
37. (Original) The method of claim 31, wherein said World Wide Web page is
designed such that said advertisement is displayed proximal to said at least one of said
plurality of messages.
- 38-44. (Cancelled)
45. (Previously Presented) A method for displaying a message in conjunction
with an advertisement on a World Wide Web page, comprising:
determining an advertisement to be displayed on a World Wide Web page;
determining a message to be displayed on said World Wide Web page,
wherein said message's subject matter is related to said advertisement's subject
matter;
determining targeting criteria associated with said message;
receiving a request to serve said World Wide Web page;
serving said World Wide Web page;
serving said advertisement for display on said World Wide Web page; and
serving said message for display on said World Wide Web page separate
from said advertisement if said targeting criteria has been met.

46. (Original) The method of claim 45, further comprising:
serving a default message if said targeting criteria has not been met.
47. (Cancelled)
48. (Original) The method of claim 45, further comprising:
determining if said targeting criteria has been met.
49. (Original) The method of claim 48, further comprising:
determining personal information.
50. (Original) The method of claim 45, further comprising:
tailoring said message based, at least in part, on said personal information, if said
targeting criteria has been met.
51. (Original) The method of claim 45, wherein said World Wide Web page is
designed such that said advertisement is displayed proximal to said message.
- 52-53. (Cancelled)
54. (Original) A method for displaying a message in conjunction with an
advertisement on a World Wide Web page, comprising:
determining an advertisement to be displayed on a World Wide Web page;
determining a message to be displayed on said World Wide Web page, said
message being associated with said advertisement;
determining targeting criteria associated with said message;
receiving a request to serve said World Wide Web page;
serving said World Wide Web page;
serving said advertisement for display on said World Wide Web page;
serving said message for display on said World Wide Web page if said
targeting criteria has been met; and

causing said message to be displayed proximal to said advertisement on said World Wide Web page if said targeting criteria has been met.

55. (Original) The method of claim 54, wherein said message is thematically related to said advertisement.

56. (Previously Presented) A method for displaying a message in conjunction with an advertisement on a World Wide Web page, comprising:

- determining an advertisement to be displayed on a World Wide Web page;
- determining a message to be displayed on said World Wide Web page,

wherein said message is associated with said advertisement;

- determining targeting criteria;
- receiving a request to serve said World Wide Web page;
- serving said World Wide Web page;
- serving said advertisement for display on said World Wide Web page;
- determining personal information;
- tailoring said message page based, at least in part, on said personal information and targeting criteria, wherein said message is thematically related to said advertisement;
- serving said tailored message for display on said World Wide Web page;

and

- causing said tailored message to be displayed proximal to said advertisement on said World Wide Web page.

57. (Cancelled)

58. (Previously Presented) A method for displaying a message in conjunction with an advertisement on a World Wide Web page, wherein the advertisement and the World Wide Web page have been served, comprising:

- determining targeting criteria associated with the advertisement;
- determining personal information;

tailoring a message based on said personal information and said targeting criteria;

serving said tailored message for display on the World Wide Web page; and
causing said message to be displayed in proximity to said advertisement on said World Wide Web page.

59. (Cancelled)

60. (Original) The method of claim 58, wherein said tailored message is thematically related to the advertisement.

61-71. (Cancelled)

72. (Previously Presented) A system for serving an advertisement, comprising:

a memory;

a communication port; and

a processor connected to said memory and said communication port, said processor being operative to:

determine an advertisement to be displayed on a World Wide Web page;

determine a message to be displayed on said World Wide Web page, wherein said message is associated with said advertisement;

determine targeting criteria;

receive a request to serve said World Wide Web page;

serve said World Wide Web page;

serve said advertisement for display on said World Wide Web page;

determine personal information;

tailor said message page based, at least in part, on said personal information and said targeting criteria; and

serve said tailored message for display on said World Wide Web page in proximity to said advertisement on said World Wide Web page.

73. (Cancelled)

74. (Previously Presented) An apparatus for serving an advertisement,
comprising:

means for establishing an advertisement to be displayed on a World Wide
Web page;

means for establishing a message to be displayed on said World Wide Web
page, wherein said message is associated with said advertisement;

means for determining targeting criteria;

means for obtaining a request to serve said World Wide Web page,

means for transmitting said World Wide Web page;

means for transmitting said advertisement for display on said World Wide
Web page;

means for retrieving personal information;

means for tailoring said message page based, at least in part, on said
personal information and said targeting criteria; and

means for transmitting said customized message for display on said World
Wide Web page in proximity to said advertisement on said World Wide Web page.

75-77. (Cancelled)

78. (Previously presented) The method of claim 14, further comprising
determining said fixed period of time.

79. (Previously presented) The method of claim 31, further comprising;
determining personal information.

80. (Previously presented) The method of claim 33, further comprising
storing said personal information prior to said determining personal information.

81. (Previously presented) The method of claim 31, wherein said serving said
advertisement includes directing a request to serve said advertisement to an ad server.

82. (Previously presented) The method of claim 46, further comprising:
determining said default message.

APPENDIX B: EVIDENCE

None.

APPENDIX C: RELATED PROCEEDINGS

None.